

**REMARKS**

(1) Claims 1-4 are canceled, and Claims 5-9 are added. Reconsideration of rejections in view of these amendments and the following remarks is respectfully requested. Claims 5-7 and 9 correspond to Claims 1-4, respectively. Claim 8 is a new scope of the invention. In Claim 5, the original limitation in Claim 1 of “---Ag or a metal and/or alloy having Ag---” is amended into the limitation of “---Ag or an alloy having Ag ---”, whose basis is found at page 8, line 24 to page 9, line 9.

(2) Rejection under 35 U.S.C. 112, second paragraph

Claims 1-4, corresponding to Claims 5-7 and 9, were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejections in this respect are believed to be overcome by the amendment.

(3) Rejection under 35 USC 103(a)

Claims 1-4, corresponding to Claims 5-7 and 9, were rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S.5,573,831). Favorable reconsideration is requested.

Suzuki et al. disclose an optical recording medium comprising a substrate, a recording layer, a metal reflective layer, a protective layer, and an outermost protective layer. The protective layer

is formed of an ultraviolet curable resin (abstract and column 2, lines 31-37).

An ultraviolet curable resin SD-17, a product of Dainippon Ink & Chemicals, Inc., which is an assignee of the present application, is used in Examples 1-3 and 5, and Comparative Examples 1-4. As shown in the Declaration in accordance with 37C.F.R.1.132 by Shoji, the pH value of SD-17 is 3.8 in an 1 wt% methanol solution.

Example 2 uses an ultraviolet curable resin, which is prepared by the procedure disclosed in col.9, lines 19-35. Applicant pursued this Example 2. The pH value of an 1 wt% methanol solution of the ultraviolet curable composition, as disclosed in Example 2, is found to be 8.2, as shown in the Declaration in accordance with 37C.F.R.1.132 by Shoji.

Thus, the pH values of an 1 wt% methanol solution of the ultraviolet curable resins disclosed in Suzuki et al. are outside the range of the present invention. The present invention is distinguish from Suzuki et al. in view of the pH value.

(4) Rejection under 35 U.S.C. 102(b), (paragraphs 6 to 8 of the OA):

EP 1058250 ("EP'250") was published on December 6, 2000, which is later than the priority date January 28, 2000 of this application. Therefore, EP'250 is not a prior art in view of 35 U.S.C. 102(b). However, WO99/34361, corresponding to and being believed to have the same content as EP1058250, was published on July 8, 1999, which is earlier than the filing date of Japanese Patent Application No. 2000-020056, to which the present application claims a foreign priority.

EP '250(WO '361) discloses an optical medium comprising a recording layer, a reflective

layer comprising Ag, a cured protective layer and an ultraviolet curable material (abstract and page 3, lines 32-38) (WO '361, abstract and page 4, lines 19-26) where the layers are analogues to films. EP '250(WO '361) discloses ultraviolet-curable materials of SD-318, SD-211, SD-17 and SD-2200, which are products of Dainippon Ink & Chemicals, Inc., an assignee of the present application, and MD-341, which is a product of Nippon Kayaku Co., Ltd.

As shown in the Declaration in accordance with 37C.F.R.1.132 by Shoji, the pH values of an 1wt% methanol solution of the ultraviolet curable resins disclosed EP '250(WO '361) are as follows: 3.2 for SD-318, 2.7 for SD-211, 3.8 for SD-17, and 2.9 for SD-2200.

Applicant made great efforts to obtain MD-341 from Nippon Kayaku Co., Ltd. Mr. Ebisawa and Applicant, Mr. Shoji, of Dainippon Ink & Chemicals, Inc. sent a letter to Mr. Hattori of Nippon Kayaku Co., Ltd., on October 1, 2002. See the attached documents to show the communications between Dainippon Ink & Chemicals, Inc. and Nippon Kayaku Co., Ltd. However, the applicant, Mr. Shoji has received a response by telephone from Mr. Futamura of Nippon Kayaku, Business Department, in place of Mr. Hattori, that Nippon Kayaku Co., Ltd. had stopped the production of MD-341, and therefore, MD-341 could not be sold to Dainippon Ink & Chemicals, Inc. Therefore, MD-341 cannot be pursued by Applicant.

The pH values of an 1wt% methanol of the other ultraviolet curable compositions disclosed in EP '250(WO '361) are outside the range of the present invention. The present invention is distinguish from EP '250(WO '361) with respect to the pH value.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**" Also, attached hereto is a Declaration in accordance with 37C.F.R. §1.132 by Shoji, and a letter and its Postal Matter Delivery Certificate with translation.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Attachments:

1. Version with markings to show changes made
2. Declaration under 37 C.F.R. §1.132
3. Copy of Letter of Mr. Ebisawa and Mr. Shoji of Dainippon Ink & Chemicals, Inc., with translation thereof
4. Copy of Certificate of Receipt Registered Post/Delivery Recording Mail, with translation thereof
5. Copy of Postal Matter delivery Certificate with translation thereof

**VERSION WITH MARKINGS TO SHOW CHANGES MADE 09/768,178**

**IN THE CLAIMS:**

Claims 1-4 have been canceled.

Claims 5-9 have been added.